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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,595

01/16/2004

Katsukuni Nitta

NITTA1

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,595	<b>Applicant(s)</b> NITTA ET AL.	
	<b>Examiner</b> LAWRENCE D. FERGUSON	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/14/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the provisional election mailed January 9, 2008.

Claims 2, 6 and 12-16 were amended rendering claims 1-28 pending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections – 35 USC 102(e)***

3. Claims 1-3, 6-10 and 12-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al (U.S. 6,562,454).

Takahashi discloses a light shielding layer (E) formed interposed between a thermoplastic resin film layer (A) and a thermoplastic resin film layer (F) (column 9, lines 42-46 and Figure 6) as in claim 1. The light shielding layer is formed by printing (column 9, lines 50-52 and column 14, lines 24-25) as in claim 6. Takahashi discloses the total light transmittance of the article is not greater than 15% (column 2, lines 15-17) as in claim 8. The light shielding layer has a black color by gravure printing, which can comprise aluminum or foil (magnetic material) (column 9, lines 50-52) which meets the limitation of claims 9-10. An additional thermoplastic resin film layer (D) (polyester

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adhesive) is coated on the surface of the thermoplastic resin film (F) (column 10, lines 1-7 and Figure 6) as in claims 14-15. Takahashi discloses the thermoplastic resins used in the invention include polyethylene terephthalate (column 3, lines 1-5) as in claim 16. The thermoplastic resin film layer (A) is coated with calcium carbonate (pigment) (column 14, lines 14-20) which meets the limitation of claim 17. In claim 18, the phrase, "outermost thermoplastic resin film is printable in any mode of electrophotography" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. The outermost layer of the material can be printed using an electrophotographic process, such as an ink jet process (column 10, lines 55-63) as in claim 18. Column 7, line 61-67 discloses the outermost thermoplastic resin is subjected to lamination, as in instant claim 19. Takahashi teaches the material is in the form of a card, security and label (column 1, lines 12-15, 23-25) where a certificate, bill, ticket, check and license are construed as a laminated structure as disclosed in column 1, lines 7-15. Because Takahashi discloses a light shielding layer with a thermoplastic resin film on both sides of the light shielding layer formed by printing, it is inherent for the layer to be shaded, which is invisible by reflected light and visible by transmitting light and for the light part of the material to have a dot ratio of from 5-70 percent, as in claims 2-3 and 7. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not

cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

In claim 1, the phrase, "processed for forgery prevention" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In claim 12, the phrase, "vapor deposited aluminum on the thermoplastic resin film" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims. In all of the above mentioned claims, the instant invention includes the preamble language of, "forgery-preventing film". Although the preamble has been considered, a preamble is generally

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not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, the preamble language has not been accorded patentable weight.

***Claim Rejections – 35 USC § 103(a)***

4. Claims 4-5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al (U.S. 6,562,454).

Takahashi does not disclose shading percentage of the light shielding material or weight percentage of adhesive filler as disclosed in claims 4-5 and 11. Takahashi discloses an adhesive applied in an amount of 0.5 to 25 g/m<sup>2</sup> having a large amount of white filler (column 9, lines 55-59 and column 10, lines 6-7).

Although Takahashi does not specifically disclose the proportion of the shading percentage of the light shielding material or weight percentage of white filler for the adhesive, shading and weight percentage are optimizable features. Applicant fails to disclose any criticality with respect to the recited “dark part of the shaded area is at least 90 percent, and that of the light part thereof is at most 10 percent,” “light part of the shaded area is from 5 to 12 percent” and “5 to 75 weight percent of white filler.”

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Therefore, in the absence of any evidence to the contrary, it would have been obvious to one of ordinary skill in the art to optimize the shading of the light shielding material and weight percent of adhesive filler because discovering the optimum or workable range involves only routine skill in the art. The light shielding material shading adhesive filler weight percentage directly affects the aesthetics of the multilayer material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. In the absence of evidence of criticality for the weight percentage of the adhesive filler material and shading percentage by Applicant, it is obvious to optimize the material. Additionally, there is also no clear teaching away from the shading percentage of the light shielding layer or weight percentage of adhesive filler in the Takahashi reference, as the reference does not exclude any percentages of the light shielding sheet or adhesive.

### **Response to Arguments**

5. The rejection(s) made under 35 U.S.C. 112, second paragraph, are withdrawn due to Applicant amending the claims to further clarify claims 2, 6 and 14.

The objection of the abstract is withdrawn due to Applicant's submitting a new abstract of the disclosure on a separate sheet, apart from any other text.

Applicants arguments to the rejection made under 35 U.S.C. 102(e) as being anticipated by Takahashi et al (U.S. 6,562,454) has been considered but is unpersuasive. Applicant argues Takahashi does not qualify as prior art under 102 as the present application is a CIP of PCT/JP02/07172, filed July 15, 2002, and claims priority

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from an application filed in Japan on July 16, 2001, whereas Takahashi, insofar as it is "prior art", is only entitled to its filing date of December 4, 2001, subsequent to applicants' priority date. The foreign priority filing date (07/16/2001) must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application and an English language translation, if the document is not in English. See 37 CFR 1.55(a)(3).

Applicant has not filed an English language translation of JP 215783/2001; therefore, the prior art has not been perfected and does not antedate Takahashi et al.

Applicant's respectfully noted that the subject matter of Takashi and the claimed invention were, at the time the present invention was made, commonly owned by Yupo Corporation or subject to an obligation of assignment to Yupo Corporation, and therefore 35 U.S.C. 103(c) comes into effect. Examiner acknowledges Applicant's argument; however, to properly invoke a 103(c) exclusion, Applicant must state the prior art (Takahashi) shall not preclude patentability, where the subject matter and claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Please See MPEP 706.02(I). This phrase has not been used; therefore, 35 U.S.C. 103(c) has not been properly invoked.

Applicant's argues Takahashi discloses something quite different from a forgery preventing film and points to several court decisions regarding preambles. While the preamble of "forgery preventing film" has been considered, the Examiner maintains it merely recites the intended use of Applicant's claimed structure. The body of the



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claim(s) do not depend on the preamble (forgery preventing film) for completeness and are able to stand alone; therefore, the preamble language has not been accorded patentable weight. Applicant further argues shading is not an inherent feature of Takahashi as it is not necessarily present. Examiner maintains, because Takahashi discloses a light shielding layer with similar materials, such as a thermoplastic resin film on both sides of the light shielding layer formed by a similar method, such as printing, it is inherent for the layer to be shaded, which is invisible by reflected light and visible by transmitting light and for the light part of the material to have a dot ratio of from 5-70 percent. Concerning claim 18, Applicant argues for a film to be printable, it requires that it have certain physical characteristics, such as a surface which is capable of being printed, such as accepting and holding print. Examiner respectfully disagrees, as a surface being printable, is has not been established in the claims how long the printable matter should be on the printable surface. Additionally, the outermost layer of the material can be printed using an electrophotographic process, such as an ink jet process (column 10, lines 55-63) as in claim 18. Applicant argues the process of vapor deposition in claim 12 properly defines the product and coatings which are vapor deposited have different physical characteristics than coatings applied in a different way. Examiner contends that aluminum applied on a surface, no matter the method used to apply the aluminum, have the same or a similar result of aluminum material on a surface.

Applicants arguments to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al (U.S. 6,562,454) has been considered but is

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unpersuasive. Applicant argues Takashi is not available because, at the time the present invention was made, both it and Takahashi were owned by Yupo Corporation or subject to an obligation of assignment to Yupo Corporation. Examiner acknowledges Applicant's argument; however, to properly invoke a 103(c) exclusion, Applicant must state the prior art (Takahashi) shall not preclude patentability, where the subject matter and claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Please See MPEP 706.02(I). This phrase has not been used; therefore, 35 U.S.C. 103(c) has not been properly invoked.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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